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10/769,117

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EXAMINER

WEST, THOMAS C

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/769,117	<b>Applicant(s)</b> FURLONG ET AL.	
	<b>Examiner</b> THOMAS WEST	<b>Art Unit</b> 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6, 13-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 13-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Status of Claims*

1. This action is in reply to the Arguments/Remarks filed October 24, 2008.
2. Claims 1-6, 13-26 are currently pending and have been examined.

### *Claim Rejections - 35 USC § 101*

3. Claims 1, 2, 13-17 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent<sup>1</sup> and recent Federal Circuit decisions, a §101 patent eligible process must (1) be tied to a particular machine (or apparatus), or (2) transform a particular article to a different state or thing. See *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008)(en banc). This is the Machine-or-Transformation Test ("M-T Test").

To meet prong (1), the method step should positively recite machine to which it is tied. Alternatively or to meet prong (2), the method step should positively recite the material that is being changed to a different state or positively recite the subject matter that is being transformed. For example, a method claim that would *not* qualify as a patent eligible process because it fails both prongs of the M-T Test would be a claim that recites purely mental steps.

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<sup>1</sup> See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

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In this particular case, the process claims fail prong (1) because the methods steps of “displaying controls”, “receiving an activation”, “creating”, “establishing”, etc. are not tied to a specific machine since the methods steps could be performed by a human being, since they could be purely mental steps. Finally, the Examiner notes that the claims fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3, 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 3, 5 recite “consulting a predetermined mapping”, the “consulting” not consistent with the specification which describes the application administrator predefines activity items. The “consulting” implies a distinct human mental step.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-6, 13-26 are rejected under U.S.C. 102(b) as being unpatentable over Vance, U.S. Patent No. 6,442,526.

**Claims 1, 3, 5:**

Vance, as shown, discloses the following limitations:

displaying controls including a first button (new trip button 362) and a second button (new trip icon button 362, col. 11, lines 41-59)

receiving an activation of the first button (new trip button 362);

after receiving the activation of the first button, in response to the activation of the first button: creating a new activity item (see new trip icon button 362, see at least col. 11, lines 41-59)

establishing a user-selected activity type (car rental button 390, fig. 14K, col. 11, lines 66-67) for the activity item wherein the establishing the user-selected activity type comprises receiving a user input selecting a single activity type (new trip icon button 362) from among a plurality of activity types (figures 15A-G, top menu bar) (see at least col. 11, lines 41-59, col. 11, lines 41-59)

the user-selected activity type (car rental button 390, fig. 14K, col. 11, lines 66-67) specifies an activity type of the activity item (new trip icon button 362, see at least col. 11, lines 41-59, col. 11, lines 41-59)

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creating an expense item (see column 8, lines 66-67, column 9, lines 1-10)

the establishing the expense type comprises consulting a predetermined mapping (autofill) from activity types to expense types to automatically establish an expense type for the created expense item (see column 8, lines 66-67, column 9, lines 1-10 autofill)

receiving an activation of the second button (new expense report fig. 16A)

creating, using a computer processor, a new expense report (new expense report fig. 16A) (see column 8, lines 66-67, column 9, lines 1-10, new expense report fig. 16A col. 12, lines 54-67)

adding all created expense items to the created expense report (see column 8, lines 66-67, column 9, lines 1-10, (new expense report fig. 16A col. 12, lines 54-67)

submitting the created expense report containing the added created expense items (see column 13, lines 26-36 (new expense report fig. 16A)

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**Claims 2, 4, 6:**

Vance, as shown, discloses the following limitations:

establishing for the activity item a date designated by a user for the activity item (see column 8, lines 66-67, column 9, lines 1-10)

establishing for the created expense item the same date designated by a user for the activity item (see column 8, lines 66-67, column 9, lines 1-10)

**Claims 13, 18, 19, 23:**

The method of claim 1, providing the user with a list of plurality of activity types (see top menu bar including: trip activity log, figures 14A-S, 14U-X and 15A-G, expense report log, figure 16H, hotel item detail, figure 16E, meals detail, figure 16F, business entertainment, figure 14Q, bargain finder, figure 14Q, col. 11, lines 41-59).

**Claim 14:**

The method of claim 13, wherein the list of the plurality of activity types is maintained by the user and contains activity item types predefined by an application administrator (see top menu bar including: trip activity log, figures 14A-S, 14U-X and 15A-G, expense report log, figure 16H, hotel item detail, figure 16E, meals detail, figure 16F, business entertainment, figure 14Q, bargain finder, figure 14Q, col. 11, lines 41-59).

**Claim 15:**

The method of claim 1, wherein the pre-determined mapping is defined by an application administrator (see column 8, lines 66-67, column 9, lines 1-10)

**Claim 16:**

The method of claim 1, wherein each of the plurality of activity types corresponds to one of appointments, meetings, presentations, trips, travel, demonstrations, and drafting correspondence (see top menu bar including: trip activity log, figures 14A-S, 14U-X and 15A-G, expense report log, figure 16H, hotel item detail, figure 16E, meals detail, figure 16F, business entertainment, figure 14Q, bargain finder, figure 14Q, col. 11, lines 41-59).

**Claims 17, 22, 26:**

The method of claim 1, wherein the application administrator predefines the plurality activity types by providing information corresponding to at least one of a description of an activity, itemized tasks associated with the plurality of activity types, whether the activity item type is associated with a particular client, and whether the activity item type is expensable (see column 2, lines 55-60, col. 11, lines 41-59, col. 11, lines 41-59).



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**Claim 20:**

The computer readable storage medium of claim 3, wherein the pre-determined mapping is defined by an application administrator (see top menu bar including: trip activity log, figures 14A-S, 14U-X and 15A-G, expense report log, figure 16H, hotel item detail, figure 16E, meals detail, figure 16F, business entertainment, figure 14Q, bargain finder, figure 14Q, col. 8. lines 66-67 and col. 9, lines 1-10).

**Claim 21:**

The computer readable storage medium of claim 3, wherein each of the plurality of activity types corresponds to one of appointments, meetings, presentations, trips, travel, demonstrations, and drafting correspondence (see top menu bar including: trip activity log, figures 14A-S, 14U-X and 15A-G, expense report log, figure 16H, hotel item detail, figure 16E, meals detail, figure 16F, business entertainment, figure 14Q, bargain finder, figure 14Q).

**Claim 24:**

The computing system of claim 23, wherein the list of activity item types is maintained by the user and contains activity item types predefined by an application administrator (see top menu bar including: trip activity log, figures 14A-S, 14U-X and 15A-G, expense report log, figure 16H, hotel item detail, figure

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16E, meals detail, figure 16F, business entertainment, figure 14Q, bargain finder, figure 14Q).

**Claim 25:**

The computing system of claim 5, wherein the activity item type corresponds to one of appointments, meetings, presentations, trips, travel, demonstrations, and drafting correspondence (see top menu bar including: trip activity log, figures 14A-S, 14U-X and 15A-G, expense report log, figure 16H, hotel item detail, figure 16E, meals detail, figure 16F, business entertainment, figure 14Q, bargain finder, figure 14Q).

***Response to Arguments***

7. Applicant's arguments with respect to claims 1-6, 13-26 have been considered but are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "plurality of activity types") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant argues that no activity types are selected from a plurality of types. Vance discloses an activity item, new trip icon button 362, col. 11, lines 41-59 and the plurality of activity types, figures 15A-G, top menu bar. The two

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distinct actions are selection of the activity item, new trip button and the car rental button 390, fig. 14K, col. 11, lines 66-67. Applicant argues that Vance does not disclose activation of the second button, creating an expense report. Vance discloses a new expense report fig. 16A col. 12, lines 54-67. Predetermined mapping described in the specification as an activity item automatically associated with a particular expense type, is shown in Vance column 9, lines 1-10 autofill.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas West whose telephone number is 571-270-1236. The examiner can normally be reached on Tuesday and Wednesday 7:30am - 5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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